# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/845,414 | 04/30/2001 | David Reyna | 40101/01801 | 2874 |

| | | |
|---|---|---|
| 30636 | 7590 | 12/22/2003 |

FAY KAPLUN & MARCIN, LLP
150 BROADWAY, SUITE 702
NEW YORK, NY 10038

| EXAMINER |
|---|
| CHAVIS, JOHN Q |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2124 | 10 |

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) | |
|---|---|---|---|
| **Office Action Summary** | 09/845,414 | REYNA ET AL. | |
| | Examiner | Art Unit | |
| | John Q. Chavis | 2124 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *30 April 2001*.

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-19* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08-24-01* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5,8* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1.    35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.    The claimed invention in claims 1, 6 and 9 are directed to non-statutory subject matter.  The applicant merely claims a method that may or may not be computer implemented. An example in which the claims may not be implemented is when the generated list is a set of numbers (which inherently have a predefined structure), extracting the desired elements..(for example, two numbers selected from a list), and performing an operation on the extracted elements (for example, adding two numbers together). A person sitting at a desk with a pencil and a piece of paper can implement this entire process. Therefore, the claims are considered non-statutory; since, the process described above would not fall into either of the useful categories listed above.

The features of claims 6 and 9 are not considered to provide anything to overcome the rejection of claim 1.

### *Claim Rejections - 35 USC § 102*

3.    The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6 and 9 rejected under 35 U.S.C. 102(b) as being anticipated by the public use of a person sitting at his desk and adding two numbers, as indicated above in

item 2. The applicant is also reminded of a user generating a playlist of songs on his

computer, extracting one or more (the desired elements) of the songs from the list and

saving or deleting (performing an operation) the songs to enable replays of only the

selected items of the original set.

4.      Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by

Ravichandran (5,966,536). The claims are now presented in a side-by-side manner with

the teachings of Ravichandran below.

| What is claimed is: | Ravichandran |
|---|---|
| 1. A method, comprising the steps of:<br>generating a list of desired elements of a first software code, | See the optimization metrics that is generated (via the abstract). |
| the first code having a predefined command structure; | Any code that is created is considered to have a predefined command structure to ensure that each step of the function is executed in order. The code generated (created) above for each block of code therefore inherently provides for the claimed features. |
| extracting the desired elements from the first code; | See also in the abstract that the optimization metrics for each block (desired element) is utilized (extracted) individually. |
| and performing an operation on the extracted elements. | An operation that is performed on the block (extracted element) would be the comparison, also specified in the abstract. |
| 2. The method according to claim 1, lines23-54.<br>wherein the code is generated parameter<br>according to the following substeps:<br>receiving parameter information via a | See the I/O interface in col. 4<br><br>In reference to receiving the<br><br>information (source executable code in col. 2 lines 39-45) via the I/O |

| | |
|---|---|
| graphical user interface, | interface (GUI) over a network, see col. 4 lines 10-21. |
| receiving handler function information via a graphical user interface, and | See the performance information and inherently information relating to transforming the initial source code (handler function information) in col. 2 lines 39-62. |
| automatically generating the first code using the parameter information and handler function information. | See col. 2 line 51-col. 3 line 10. |
| 3. The method according to claim 1, wherein the list of desired elements includes a list of language translatable elements and | See the rejection of claim 2 above. |
| wherein the performing step includes the following substeps: translating the extracted elements from a first language into a second language. | See again the converting and optimization (translating) indicated in claim 2. |
| 4. The method according to claim 3, wherein the performing step includes the following substep: inserting the translated elements back into the first code. | See the use of the most efficient block (translated elements) in col. 3 lines 11-23. |
| 5. The method according to claim 3, wherein the performing step includes the following substep: generating a second code as a function of the first code and the translated elements. | The converting function in claim 3 is considered the first code; while, the optimization function providing for the second code. |
| 6. The method according to claim 1, wherein the list of desired elements includes a list of help-related elements and wherein the performing step includes the following substeps: generating a help manual as a function of the extracted elements. | The performance feature is considered to provide for the help related elements and the benchmarks are also considered similar to a help manual, see col. 3 lines 24-60. |
| 7. The method according to claim 1, wherein the list of desired elements is | See again the rejection of claim 2 above and col. 9 lines 14-33. |

generated via a command graphical
user interface.

| | |
|---|---|
| 8. The method according to claim 1, wherein a command graphical user interface displays the extracted elements. | This feature is considered inherent via col. 9 lines 45-67. |
| 9. The method according to claim 1, wherein the predefined command structure is a hierarchical command tree. | See col. 6 lines 43-66. |
| 10. The method according to claim 1, wherein the predefined command structure is displayed via a graphical user interface. | This feature is also considered inherent via the information cited in the rejections of claims 7-9 above. |

Claims 11-14 are rejected in view of the rejections of the method claims 1-4

above in view of

As per claims 14-19, see the rejections of claims 6-10 above in view of

Ravichandran's apparatus (system) claims 7-10.

5.     Any inquiry concerning this communication or earlier communications from the

examiner should be directed to John Q. Chavis whose telephone number is 703-305-

9665. The examiner can normally be reached on 8:30 am-5:00 pm Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kakali Chaki can be reached on 703-305-9662. The fax phone number for

the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-306-

3900.

Jqc
December 12, 2003

JOHN CHAVIS
PATENT EXAMINER
ART UNIT 2124